

4  
inflate the balloon through the second opening (which is in communication with the interior of the balloon).

Ackerman in view of Valtchev fail to establish a *prima facie* case of obviousness of the invention because the combined references do not teach or suggest all the limitations of the claims.

Ackerman teaches a double-lumen, intracervical/intrauterine catheter device. One of the two lumens of this device provides a communication passageway which allows the dispensing of a diagnostic fluid into the uterine cavity. The other one of the two lumens provides a communication passageway for inflating the balloon with a fluid such as saline or air.

Valtchev, in the embodiment of Fig. 7, teaches a single channel balloon uterine injector that includes an elongated member 12 with a first fluid communication passageway 13 extending to a barrier 15 and a second fluid communication passageway 16 extending from the barrier 15 to the other end of the elongated member 12. External openings 18 are provided adjacent to the first end of the elongated member 12 for dispensing diagnostic fluid into the uterine cavity. An inflatable balloon 20 is bonded to the elongated member 12 in a location that surrounds the barrier 15, and an opening 23 allows fluid communication between fluid communication passageway 13 and balloon cavity 24. The barrier 15 includes an opening 26' which allows fluid communication between fluid communication passageway 16 and fluid communication passageway 13. The opening 26' in the barrier 15 has a diameter which is much smaller than opening 23 so that the opening 26' forms a restriction which allows the balloon 20 to inflate as flow goes through opening 26'. Hence, the external openings 18 in Valtchev do not generate a back-flow within the fluid communication passageways 16 and 13, which would cause the fluid to enter and inflate the balloon as presently claimed.

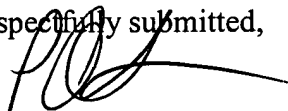
The examiner's argument regarding the claimed areas of the openings is also in error. The areas of the openings enable the external opening of the claimed invention to generate a back-flow within the lumen, as explained in the specification on page 5, lines 16-19 and page 6, lines 9-13. Therefore, the Federal Circuit case cited by the examiner does not apply to the subject matter of claims 22 and 23.

Since Ackerman in view of Valtchev fail to teach or suggest all the structural limitations of the claims, withdrawal of the rejection under 35 USC 103 (a) is respectfully urged.

Favorable reconsideration of this application is respectfully requested as it is believed that all outstanding issues have been addressed herein and, further, that claims 1-7, 9, 11-16, 22, and 23 are in condition for allowance, early notification of which is earnestly solicited. Should there be any questions or other matters whose resolution may be advanced by a telephone call, the Examiner is cordially invited to contact Applicant's undersigned attorney at his number listed below.

No fee is believed to be due as a result of this communication. The Commissioner is hereby authorized to charge any other fees which may be required or credit any overpayment to Deposit Account No. Deposit Account No. 50-2061.

Respectfully submitted,



---

Paul A. Schwarz, Esq.  
Reg. No. 37,577

DUANE MORRIS LLP  
100 College Road West, Suite 100  
Princeton, New Jersey 08540  
(609) 919-4408  
(609) 919-4401 - facsimile